

### REMARKS

Claims 1, 4, 6 and 7 are in the case.

With this amendment, Claim 1 has been revised to clarify the fact that the wheels of the tractor unit are directly powered by the internal combustion engine. Thus, Applicant now defines an improvement which can be applied to conventional tractor trailer units presently on the road. In such units, the tractor unit is directly powered by the internal combustion engine. Applicant, however, is adding an arrangement wherein the trailer unit is driven by electric motors.

The above amendment is believed to clearly distinguish over the cited prior art. Clearly Moll et al cannot respond to the limitation of the tractor unit being powered by the internal combustion engine. Rather, Moll et al uses electric drive means on both the tractor unit and the trailer unit.

With respect to the combination of references, Long et al is directed to a conventional hybrid electric vehicle and not to a tractor trailer arrangement wherein one portion is driven by the internal combustion engine and the trailer unit has the electric drive means. Long et al discloses a conventional hybrid parallel arrangement wherein an electric motor adds power output to the already operating internal combustion engine such as when the engine is called upon to produce a rapid speed RPM change such as during acceleration. This is clearly a different arrangement from what is defined in Claim 1.

It is respectfully submitted that the combined teachings of the references applied by the Examiner fail to disclose or even suggest the subject matter of the claims at issue.

There is nothing in the cited art to suggest what Applicant did. In fact, these references do not even contain any suggestion that they could be combined in the manner proposed by the Examiner. However, this is a prerequisite for a combination rejection, as stated by the Patent Office Board of Appeals in its decision in *Ex parte Walker*, 135 USPQ 195:

*"In order to justify combination of references it is necessary not only that it be physically possible to combine them, but that the art should contain something to suggest the desirability of doing so."*

The Court of Customs and Patent Appeals subscribed to the Board's reasoning, when it handed down its decision in the case *In re Imperato*, 179 USPQ 730, holding:

*"The fact that the disclosures of references can be combined does not make combination obvious unless the art also contains something to suggest the desirability of such a combination."*

*With regard to the principal rejection, we agree that combining the teaching of Schaefer with that of Johnson or Amberg would give the beneficial result observed by appellant. However, the mere fact that those disclosures can be combined does not make the combination obvious unless the art also contains something to suggest the desirability of the combination. In re Bergel, 48 CCPA 1102, 292 F.2d 955, 130 USPQ 206 (1961). We find no such suggestion in these references."*

In fact the art must not only be combinable in accordance with the principles of the above decisions, but to support a valid combination rejection the art must also suggest that the combination would accomplish Applicant's results. This was stated by the Patent Office Board of Appeals in the case *Ex parte Tanaka, Marushima and Takahashi* (174 USPQ 38), as follows:

*"Claims are not rejected on the ground that it would be obvious to one of ordinary skill in the art to rewire prior art devices in order to accomplish Applicant's result, since there is no suggestion in prior art that such a result could be accomplished by so modifying prior art devices."*

It is also well settled that an inventive combination cannot be anticipated by finding individual features separately in the prior art and combining them in a piecemeal manner to show obviousness. Note would be taken in this connection of the decision of the Court of Customs and Patent Appeals *In re Kamm and Young*, 17 USPQ 298 ff, which appears most pertinent to the issues at hand and wherein the claims were also rejected over a combination of references. The Court held that:

*"The rejection here runs afoul of a basic mandate inherent in section 103 - that 'a piecemeal reconstruction of the prior art patents in the light of appellants' disclosure' shall not be the basis for a holding of obviousness. In re Rothermel, 47 CCPA 866, 870, 276 F.2d 393, 396, 125 USPQ 328, 331 (1960). 'It is impermissible within the framework of section 103 to pick and choose from any one reference only so much of it as will support a given position, to the exclusion of other parts necessary to the full appreciation of what such reference fairly suggests to one of ordinary skill in the art.' In re Wesslau, 53 CCPA 746, 750, 353 F.2d 238, 241, 147 USPQ 391, 393 (1965)." Emphasis added.*

In view of the above, it is respectfully submitted that this application is now in order for allowance and such action is respectfully solicited.

Respectfully,




Eric Fincham  
Reg. 28,201

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